

Remarks

In response to the Office Action dated August 15, 2006, Applicant respectfully requests reconsideration based on the above claim amendment and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 1-3, 5-10, 12-14 and 16-28 are currently pending. Claims 1, 5-7, 18, 20-21, 25 and 27 have been amended and claims 4, 11 and 15 have been previously cancelled without prejudice. No new matter has been added. No new claims have been added. Applicant asserts that all claims are in condition for allowance as set forth more fully below.

Interview Summary

A phone interview was conducted on October 12 between Arno Naeckel, Applicant's representative, and Examiner Ramakrishnaiah. During the interview it was discussed that none of the references described the feature of adding, deleting and editing an alert file while stored within the wireless communication device. Support for such a feature was found in paragraph [0008] of the specification. It was further discussed that the Stone reference described an alert generated by a digital clock in a cell phone but did not describe triggering an alert in response to a signal from the cell phone to the battery powering the cell phone.

Double Patenting Rejections

Claims 1-28 stand rejected under the nonstatutory double patenting doctrine in relation to claims 1-20 of App. 09/964,385 and over claims 1-20 of App. 10/101,630. As this is a provisional rejection, since none of the claims have yet to be patented, Applicant respectfully asserts that a terminal disclaimer would be premature and reserve the right to respond to such double patenting rejections in the future upon such claims being patented.

103 Rejections

Claims 5-6 and 21 stand rejected under 35 USC §103(a) as being unpatentable over Stone (US Pat 5,767,778) in view of Suzuki (US Pat 6,556,665). Claims 1-3, 7-10, 12-14, 16-20 and 22-24 stand rejected under 35 USC §103(a) as being unpatentable over Stone in view of Haraguchi (US Pat. 6,597,279) and Suzuki. Claims 25-28 stand rejected under 35 USC §103(a) as being unpatentable over Stone in view of Haraguchi, Suzuki and Sawada (US Pat 6,810,274).

Claims 1-3, 5-10, 12-14, 16-28

Applicant asserts that amended independent claims 1, 5-7, 18, 20-21, 25 and 27 each recite additional subject matter not disclosed or suggested by Stone, Suzuki or Haraguchi nor any combination thereof. The additional subject matter is supported in paragraphs [0027-0029] of the specification. As a representative sample, amended claim 1 recites in pertinent part:

“[a] device that plays alerts and is used with a wireless communication device... wherein the alert generating device is triggered to play an alert associated with the file upon detection of a signal from the wireless communication device to the battery generated by an incoming communication by the wireless communication device and an event at the wireless communication device other than an incoming communication...”

The Office Action concedes that Stone fails to describe playing an alert associated with the file upon detection of an event at the wireless communication device other than an incoming communication. However, the Office Action proceeds by asserting that Suzuki cures the deficiency of Stone. Specifically, the Office Action cites Suzuki as disclosing that when the audio alert is used as an alarm sound, a predetermined time is set as in the case of an alarm clock. When the predetermined time occurs, the CPU reads the audio signal out of memory. (Col. 4, l. 14-17). Suzuki does not describe that the alert generating device is triggered to play an alert upon detection of a signal from the wireless communication device to the battery generated by an event at the wireless communication device other than an incoming communication. In fact, Suzuki fails to describe at all how the CPU is triggered to read the audio signal out of memory. Further, neither Haraguchi nor Sawada addresses the issue. Therefore, since none of the cited references describe that the alert generating device is triggered to play an alert upon detection of a signal from the wireless communication device to the battery generated by

an event at the wireless communication device other than an incoming communication, their combination is also deficient.

Further, there is no motivation to combine Stone and Suzuki because Stone teaches away from detecting signals in order to produce an alert for a reason other than an incoming call. There would also be no reasonable chance of success even if Stone were modified to include a clock. Stone teaches that the microprocessor is programmed to minimize false alerts by restricting a generation of an alert to those events characterized by a certain duration of power consumption or a certain sequence of power consumption levels characteristic of an incoming call. (Col. 6, l. 60, Col. 7, l. 8). By restricting an alert to the detection of a certain a pattern of consumption levels associated with an incoming call, Stone teaches away from producing an alert for events other than an incoming call. The Office Action concedes that Stone only describes the power events of an incoming call. Therefore, merely adding a clock whereby an output indicates that an event has occurred would not be a series of power draws recognized by the processor (i.e. it would be a false alert) and an alert would not be generated. Therefore the modification would have no reasonable chance of success. A reasonable chance of success is required. MPEP 2143.02.

Furthermore, since Stone describes only alarming on an incoming call, a modification of Stone to ring for other events would be required and that would change the principle of operation of Stone. A proposed modification can not change the principal of operation of a reference. MPEP 2143.01.

For the above reasons, the amended independent claims 1, 5, 6-7, 18, 20-21, 25 and 27 are allowable over the cited references in any combination. Dependent claims 2-3, 8-10, 12-14, 17, 19, 22-24, 26 and 28 variously depend from allowable independent claim 1, 7, 16, 18, 21, 25 or 27 and are allowable for at least the same reasons.

Claims 5, 8 and 10

Applicant asserts that amended independent claim 5 recites additional subject matter not disclosed or suggested by Stone, Suzuki, Haraguchi or Sawada nor any combination thereof. Independent claim 5 and dependent claims 8 and 10 recite similar subject matter. As a representative sample, claim 5 recites, in pertinent part:

“[a] device for a wireless communication device that plays alerts...comprising... an external connector socket on the shell in electrical communication with the alert generating device to provide external access for adding alert files, deleting alert files and editing alert files in the alert generating device...”.

Support for the claim element can be found in the last sentence of paragraph 0008 in the Applicant's specification where editing sound files is expressly described in addition to deleting or adding sound files. Editing a file and deleting a file are two very different operations.

Sawada and Haraguchi concern themselves with persistent memory for alerts and the selection of alerts using a jog dial for portable communications units, respectively and do not discuss editing alerts files or sound files. Stone discusses adding and deleting sound files using a personal computer (Col. 7, l. 25-28) by drawing from a library of music or sound bites. Suzuki describes recording a sound bite by recording a sound bite via a microphone in a portable phone, digitizing the sound bite and compressing it for use as a calling or alert sound. (Col. 3, l. 58-Col. 4, l. 13). Neither Stone nor Suzuki teaches, discloses or suggests providing external access to the alert file in the alert generating device for editing the alert file while stored in the wireless communication device. Since neither Sawada nor Haraguchi addresses the issue and neither Stone nor Suzuki describes or suggests the editing of alert files, then a combination of any or all of the references listed fail to describe all of the elements of claims 5, 8 and 10.

Conclusion

Claims 1-3, 5-10, 12-14 and 16-28 are pending, claims 1, 5-7, 16, 18, 20-21, 25 and 27 have been amended and claims 4, 11 and 15 have been cancelled without prejudice. Applicant requests reconsideration based on these amendments and arguments. Should the Examiner have any questions, please contact the undersigned.

No additional are believed due. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025.

Respectfully submitted,

Date: November 14, 2006

/Arno T. Naeckel/

Arno T. Naeckel

Reg. No. 56,411

Withers & Keys, LLC
P.O. Box 71355
Marietta, Ga 30007-1355
(404) 849.2093